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2341.6                      7590                      01/28/2011 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
KEYS, ROSALYND ANN				
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THOMAS GENDER, CARSTEN OOST,  
JOOST-WILLEM SNOECK, MANFRED STROEDEL,  
JENS BECKER, and WILFRIED BERNING

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Appeal 2009-015183  
Application 10/525,468  
Technology Center 1600

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Before JEFFREY T. SMITH, BEVERLY A. FRANKLIN, and  
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1, 8, and 12. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

We REVERSE.

### STATEMENT OF THE CASE

The subject matter on appeal is directed to a process for oxidizing cyclohexane with air.

The Examiner maintains the rejection of claims 1, 8, and 12 under 35 U.S.C. § 103(a) over Ciburowski (US 3,349,007, issued Oct. 24, 1967) in view of Rapoport (US 3,957,876, issued May 18, 1976) and Luebke (US 5,449,501, issued Sep. 12, 1995) and further in view of Crouch (US 2,931,834, issued Apr. 5, 1960) and Lewis (HAWLEY'S CONDENSED CHEMICAL DICTIONARY 1139 (12th ed. 1993)).

### ISSUE

Did the Examiner reversibly err in determining that it would have been obvious to one of ordinary skill in the art to substitute the catalytic distillation column of Luebke for, *inter alia*, the rectifying column of Ciburowski within the meaning of § 103? We decide this issue in the affirmative.

### PRINCIPLE OF LAW

A proposed modification or combination of the prior art that would change the principle of operation of the prior art invention being modified,

weighs against a conclusion of prima facie obviousness. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

#### ANALYSIS AND CONCLUSION

The Examiner determined that it would have been obvious to one of ordinary skill in the art to substitute the catalytic distillation column of Luebke for, *inter alia*, the rectifying column of Ciborowski. (See Ans. 4-6).

We disagree with the Examiner's determination for the reasons stated by Appellants at pages 4 through 6 of the Appeal Brief and pages 2 through 4 of the Reply Brief.

Ciborowski teaches at column 1, lines 38-52 and column 2, lines 7 through 23 that the "essence" of its invention (i.e., the principle of operation) involves condensing compressed vapors of the same substance in the heating coil of a rectifying column in order to use the heat of condensation of the compressed vapors to evaporate liquid in the rectifying column. (App. Br. 4). Thus, we agree with Appellants that the substitution of Luebke's catalytic distillation column for, *inter alia*, the rectifying column of Ciborowski would have destroyed this principle of operation. See *Ratti*, 270 F.2d at 813.

Therefore, it follows that it would not have been obvious to one of ordinary skill in the art to substitute the catalytic distillation column of Luebke for, *inter alia*, the rectifying column of Ciborowski within the meaning of § 103.<sup>2</sup>

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<sup>2</sup> Appellants have not presented arguments directed to the other applied prior art references (i.e., Rapoport, Crouch, and Lewis).

DECISION

Accordingly, the Examiner's decision is reversed.

REVERSED

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